TTAB

Attorney Ref.: 201091

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SMITHKLINE BEECHAM CORPORATION, Opposer, v. THERAOX, INC., Applicant.	Opposition No.: 91/160,810

OPPOSER'S OPPOSITION TO APPLICANT'S "MOTION TO RESCHEDULE PROCEEDINGS BASED ON GOOD CAUSE AND MOTION TO COMPEL"

Opposer, by its attorney, hereby opposes Applicant's "motion to reschedule proceedings based on good cause and motion to compel." As more fully discussed below, Applicant's motion is not well taken and should be denied.

I. Background

This opposition was filed by Opposer seeking to prevent registration of Applicant's mark OXIUM which is the subject of application Serial No. 78/116,976. The opposition was instituted on June 9, 2004 by order of the Trademark Trial and Appeal Board and the June 9, 2004 trial order specifically set forth the discovery period to close on December 26, 2004.

Applicant did not serve any discovery requests on Opposer during the scheduled discovery period which, as noted above, closed on December 26, 2004. Applicant, however, did send Opposer's counsel a set of interrogatories and document requests, which discovery requests

were accompanied by a certificate of service indicating service of these discovery requests on January 7, 2005.

On January 18, 2005, Opposer's counsel advised Applicant's attorney that, while Applicant's January 7, 2005 discovery requests were received, Opposer did not intend to respond to these requests since they were untimely, being served after the discovery period had already closed.

Applicant's "motion to reschedule proceedings and motion to compel" was then filed and served on Opposer's counsel with a certificate of service dated February 11, 2005.

II. Opposer's Motion Is Not Well Taken And Should Be Denied

Applicant's motion essentially requests that the discovery period be re-opened due to a docketing error on the part of the Applicant. Specifically, the sum and substance of Applicant's motion is that there was a second opposition filed against Applicant's mark by another party; that the closing date of the discovery period in the second opposition was January 9, 2005 and that Applicant incorrectly docketed the discovery deadline in both cases as January 9, 2005 when, in fact, the discovery deadline in this case was December 26, 2004.

While Applicant has essentially argued that its error in docketing is good cause to justify a rescheduling of the discovery period, Applicant has not even set forth the correct standard for a motion of this type. It is clear that, where, as here, the time for taking a required action has expired, the party desiring to take the required action must file a motion to re-open the time for

taking that action and the moving party must show that its failure to act during the time previously allotted therefor was the result of excusable neglect. See Rule 6[b] Fed. R. Civ. Proc. and TBMP Section 509.01[b][1]. Applicant's motion does not even mention the applicable excusable neglect standard, let alone come anywhere close to demonstrating that such standard has been met. In this regard, it has repeatedly been held that a mere docketing error is wholly within counsel's control and cannot justify the re-opening of a time period under the excusable neglect standard. See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg., Co., 55 USPQ2d 1848 [TTAB 2000] and cases cited therein.

With respect to the other "facts" set forth in the motion, they are entirely irrelevant to the docketing error of the discovery deadline in this case. Specifically, Applicant's attorney indicates that she was involved in other litigation and was out of her office for a good portion of November and December 2004. Such other litigation responsibilities have absolutely nothing to do with the mis-docketing of the discovery deadline in this case, since Applicant was aware of the Board's institution letter and trial order which issued on June 9, 2004.

Applicant's attorney also states that her secretary left the firm and a temporary secretary was assigned in late October 2004 who was unfamiliar with counsel's cases and unfamiliar with TTAB proceedings. However, the reassignment of a temporary secretary in October 2004 can have nothing to do with a docketing error of the discovery cut-off, since Applicant was aware of the Board's June 9, 2004 institution letter and trial order.

Finally, Applicant's attorney indicates that she was involved in an accident which required hospitalization and medical attention in January 2005 and this has contributed to the delay in responding to Opposer's January 18, 2005 letter. While this is, of course, unfortunate, it is not understood how the accident relates in any way to the reason for the untimely serving of the discovery requests in early January 2005 when the discovery cut-off was December 26, 2004, well before any medical problems occurred.

Applicant's motion also includes a section requesting the Board to compel Opposer to respond to Applicant's untimely discovery requests. While the motion to compel simply requests that the Board re-set the discovery period and require Opposer to provide responses to the discovery requests, it is clear that such a motion to compel is not well taken since the failure of Opposer to respond to the discovery requests was proper given the fact Applicant's discovery requests were untimely.

Finally, it is noted that Applicant's motion does not address the issue relating to the fact that the discovery period opened on June 29, 2004 and Applicant had some six [6] months in which to take discovery of Opposer. This is more than enough time to complete discovery in the most complex litigation matters. It is certainly more than enough time to take and complete discovery in a straightforward Section 2[d] likelihood of confusion opposition.

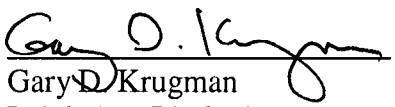
III. Conclusion

Applicant's motion to reschedule the discovery period and motion to compel is not well taken. As discussed above, the motion to reschedule is, in fact, a motion to re-open the discovery period, which motion is wholly unsupported by any showing of excusable neglect. The discovery deadline was simply mis-docketed by Applicant's counsel and it is well settled that a simple docketing error in and of itself cannot justify a re-opening of the discovery period.

For the foregoing reasons, Applicant's motion should be denied and the case should proceed to trial.[1]

Respectfully submitted,

SMITHKLINE BEECHAM CORPORATION

By: 

Gary D. Krugman
Leigh Ann Lindquist
Attorneys for Opposer
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Date: February 17, 2005

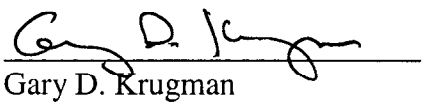
[1] Under the Board's current Trial Order, Opposer's testimony period is set to open on February 25, 2005. Since it is likely that the instant motion will not be decided until Opposer's testimony period has run, and it is uncertain, until this motion is decided, whether the Board will in fact reschedule the discovery period, Opposer respectfully requests that the Board reschedule the testimony periods in this case.

Attorney Ref.: 201-091
Oppos. No. 91/160,810

CERTIFICATE OF SERVICE

I, Leigh Ann Lindquist, Esquire, hereby certify that on this 17th day of February, 2005, true and correct copies of the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S "MOTION TO RESCHEDULE PROCEEDINGS BASED ON GOOD CAUSE AND MOTION TO COMPEL"** have been properly served, via First Class U.S. Mail, postage prepaid to:

Tawnya R. Wojciechowski, Esq.
SHEPPARD, MULLIN, RICHTER, & HAMPTON LLP
650 Town Center Drive, Fourth Floor
Costa Mesa, California 92626



Gary D. Krugman